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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,867	12/03/2003	Armin Herb	DT-6703	5395
30377	7590	02/10/2005	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			SHARP, JEFFREY ANDREW	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/726,867

**Applicant(s)**

HERB, ARMIN

**Examiner**

Jeffrey Sharp

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of Claims*

- [1] Claims 1-13 are pending.

### *Specification*

- [2] The disclosure is objected to because of the multiple informalities. A few examples are, but not limited to:

Page 10 (second to last line), '*spacer element 11*' is incorrect, as it shares the same identifier numeral as '*back grip member 11*'. The limitation '*spacer element*' should be numbered with the identifier numeral '*14*'.

Page 11 (line 7), '*stop 112*' should be --stop 12--.

Page 12 (line 12), '*elemetn 31*' should be --element 31--.

Page 12 (line 13), --35.2-- should be inserted before '*clip 34.2*'.

Page 15 (line12), '*sum*' should be --summary--.

etc....

Appropriate correction is required.

### *Claim Objections*

- [3] The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

[4] Claims 1, 3- 5, and 7-9 are objected to because of the following informalities:

Claim 1 (as well as all depending claims) uses functional language that does not necessarily create positive limitations. The functional language seems to be the result of a direct German translation. For example, claim 1 lines 1-2 state '*for introduction into a mounting opening*'. If a mounting opening is to be part of the claimed structure, Applicant is urged to rephrase: --**introduced** into a mounting opening--. On claim 1 line 4, the phraseology '*for front outward biasing*' is not clear, as no reference to a '*front*' or '*outward*' direction has been made.

Claim 3 does not suggest whether '*axial movement*' (line 8) is in relation to the fastening means or along the hollow body. Regardless, this statement is a non-limiting functional recitation, as it follows the words '*can be...*'.

Claim 4 has been interpreted as having twice as many complimentary securing means on the stop as securing means on the spacer element.

Claim 5 has insufficient antecedent basis for the limitation '*the connection*' (line 3). It is unclear as to what interaction is taking place, because Applicant does not disclose where the '*recesses*' reside. It is advised that Applicant suggest that the stop (12; 53; 65) comprises the recesses (16.1, 16.2; 69.1, 69.2).

Claim 7 is unclear, as any direction or surface of the rear grip member can be considered '*facing away from the rear grip member*'. It is suggested Applicant rephrase lines 2 and 3 to read --annular element arranged on the rear grip member towards the stop--.

Claim 8 is unclear, as the clamping force by the clips would be parallel to the stop, not perpendicular. Applicant is urged to insert --; wherein said holding projections (6.1, 6.2; 75.1,

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75.2) are situated-- before '*perpendicular to the stop*' on line 4. Note that claim 1 does not suggest that the holding projections are perpendicular to the stop, but rather only '*arranged in the hollow body*'.

Claim 9, the word '*the*' should be replaced with --each-- before '*clip*' on line 1 for clear antecedent basis. Also, functional language should be placed after '*integrated stop (35.1, 35.2)*', in order to suggest the function of the integrated stop and interaction between the gripping holding projections (6.1, 6.2; 75.1, 75.2).

Claim 10, there is insufficient antecedent basis for '*the spring biased elements*' (line 2). Applicant only states that the securing means is functionally '*spring biased*' in claim 1, last line.

Appropriate correction is required. All claims have been treated on their merit, as they are definite.

### ***Claim Rejections - 35 USC § 102***

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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[6] Claims 1-7, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Plank et al. US-5,655,865.

Plank et al. '865 substantially teaches a fastening element comprising a rear grip member (1), first and second positions, a mounting opening (14) of a hollow body (12), at least one stop (9) having two complimentary securing means (annular recess under 9 partially receiving projections 6 and creating one of a first or transport position having a depth less than complimentary recess 10, which fully-receives the spring biased projections in one of a second and a securing position), a separate annular spacer element (5) arranged between a stop (9) and the rear grip member (1), comprising diametrically-opposed spring biased projections (6), and a fastener means to connect the rear grip member (1) to the stop (9) (see Col 5 line 58).

Note that Plank et al. '865 discloses elements (7, 11) on a separate annular spacing element (5), which is analogous to Applicant's detent elements (42.1-42.4). The elements (7, 11) serve as engagement means to secure the separate annular spacing element (5) to the upper portion of rear grip member (1).

Claim 4 has been interpreted as having twice as many complimentary securing means on the stop as securing means on the spacer element. Plank et al. '865 clearly shows twice the complimentary securing means on the stop (9) as there are securing means (6) on the separate annular spacing element (5). Two securing recesses (10) and the two diametrically opposed annular transport recesses under (9) of lesser depth equals twice the number of securing means projections (6).

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[7] Claims 1-6, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Höfle US-5,489,173.

Höfle '173 shows the same limitations as Plank et al. '865 discussed above, except for those limitations found in claim 7. Instant claim 7 is interpreted as requiring the spacer element (5) to be arranged on the fastening element near the rear grip member facing towards the stop, consistent with Applicant's disclosure -- see above claim objections.

Höfle '173, as required by claim 1, shows annular and projection portions (8,6) of the spacer element (5) being disposed between the stop (9) and rear grip member (1); however, the spacer element (5) is secured to the rear grip member (1) via (7) on the blind side facing away from the stop.

### ***Claim Rejections - 35 USC § 103***

[8] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant states that:

*'The drawback of the prior art solution is that the known fastening element comprises a number of co-operating elements and is expensive to manufacture'*

And that:

*'The object of the present invention is to provide a fastening element having a rotatable rear grip member, which allows pre-fixing, which assures correct positioning of the rear grip member relative to the holding projections. Furthermore, the fastening element is intended to*

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*comprise few parts that are simple to manufacture. Furthermore, the fastening element is intended to be easy to manage and allow simple assembly.'*

Although the prior art may include additional structure not required by Applicant's invention, it must be noted that fact that it discloses additional structure is irrelevant.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to reduce the number of interacting parts the prior art teaches, for simplicity and ease of manufacturability, since it has been held that the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

[9] Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plank et al. US-5,655,865 or Höfle US-5,489,173 in view of Rinderer US-RE 36,681.

Höfle '173 and Plank et al. '865 show all the limitations as the instant claim 1 as discussed above. However, Höfle '173 and Plank et al. '865 fail to suggest a pair of diametrically opposed spring-biased clips (19.1, 19.2; 34.1, 34.2; 74.1, 74.2) that apply a laterally-perpendicular clamping force against the depending gripping holding projections (6.1, 6.2; 75.1, 75.2).

Rinderer '381 suggests a spacing member comprising a plurality of diametrically opposed resilient (i.e., 'spring biased') clips (50, 58), which apply a force against the gripping holding projections (L). This force helps keep the fastening element assembly in frictional engagement with the projections (L) to prevent sliding along the C-channeled hollow body (C), and to enable 'finer-tuned' axial location of the fastening element assembly along the C-shaped hollow body (C).

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At the time of invention, it would have been obvious to one of ordinary skill in the art, to modify the spacing member taught by either Höfle '173 or Plank et al. '865 to comprise '*diametrically opposed spring-biased clips*' as suggested by Rinderer '681, in order to 1) prevent inadvertent sliding along the C-channeled hollow body (C), and to 2) improve and 'fine-tune' the axial location of the fastening element assembly along the C-shaped hollow body (C) by the increase in friction. The clip members may also, as suggested by Applicant, 3) help keep the entire assembly (including the rear grip member) in one of a second and securing position.

Note that the clips may be considered '*integrated stops*' as suggested in claim 9.

See, also Stover US-4,666,355, which shows diametrically opposed spring-biased clips (34) on a spring-biased spacer element (20), that provide the same function (Figures 3 and 4).

[10] Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Plank et al. US-5,655,865 or Höfle US-5,489,173 in view of Rinderer US-RE 36,681 as discussed above, in further view of Fröhlich US-6,086,300.

Höfle '173 or Plank et al. '865 v. Rinderer '381 teach all of the limitations disclosed in the instant claim 8, including two spring-biased clips (which could be considered '*integrated stops*').

However, Höfle '173 or Plank et al. '865 v. Rinderer '381 fails to disclose expressly '*integrated stops*' substantially shown by Applicant.

Fröhlich teaches the benefit of integrated stops (9), which are well-known in the art. See Fröhlich Col 4, lines 4-5, for one simple motivation.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the fastening element taught by Höfle '173 or Plank et al. '865 v. Rinderer '381, to

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comprise an integrated stop as suggested by Fröhlich '300 as well as the prior art, in order to 1) create a tactile or acoustic engagement into one of a second and securing position. An integrated stop having a flat thereon would 2) provide further anti-rotational benefits to the assembly, as well as 3) contribute to the abovementioned frictional advantages of the clips. Lastly, an integrated stop would 4) create an alignment surface as suggested by Fröhlich '300.

### *Conclusion*

[11] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows:

Application s/n 10/728252 (Applicant) discloses a similar fastening element.

US-4,741,582 Peroni shows tabs (22) similar to Applicant's tabs 73.1 and 73.2

US-4,666,355 Stover teaches an annular spacing element having two clips (34) that engage the gripping holding projections (16).

US-5,199,836 Gogarty shows profile (50) having a integrated stop, similar to the profile of Applicant's clip with integrated stop (embodiment in Figure 3; 34.1 and 35.1).

DE 10052534 Herb suggests detent means (16, 17, 18, 25) for securing a similar fastener in a position.

WO 9836180 A1

FR 2636687 A1

US 5628598 A

US 5209619 A

US 5022804 A

US 20040165965 A1

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EPO DOBSON, MARY

EPO BUISSON, BERNARD et al.

USPAT Hofle; Siegfried

USPAT Rinderer; Eric R.

USPAT Peterson; Francis C.

US-PGPUB Unverzagt, Stefan et al.

USPAT Schmidt; Bernhardt J.

USPAT Pletcher; Donald L.

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US 4575295 A	USPAT	Rebentisch; Hugo E.
US 4460299 A	USPAT	Kowalski; Joseph W.
US 4285379 A	USPAT	Kowalski; Joseph W.
US 4263952 A	USPAT	Kowalski; Joseph W.
US 3483910 A	USPAT	HUFFEL JAMES HOWARD VAN et al.
US 2886872 A	USPAT	D AMELIO LOUIS A
US 4840525 A	USPAT	Rebentisch; Hugo E.
US 4666355 A	USPAT	Stover; David R.
US 4410298 A	USPAT	Kowalski; Joseph W.
US 6575680 B2	USPAT	Herb; Armin et al.
US 6146071 A	USPAT	Norkus; James et al.
US 5577860 A	USPAT	Plank; Wolfgang
US 20040165964 A1	US-PGPUB	Herb, Armin
US 5630686 A	USPAT	Billmann; Peter
US 5411356 A	USPAT	Travis; Harry et al.
US 5375798 A	USPAT	Hungerford, Jr.; Charles S.
US 5199836 A	USPAT	Gogarty; Brian J.
US 5118233 A	USPAT	Mitchell; Eugene R.
US 4917553 A	USPAT	Muller; Franz
US 4830531 A	USPAT	Condit; Timothy B. et al.
US 4784552 A	USPAT	Rebentisch; Hugo E.
US 4741582 A	USPAT	Peroni; Peter A.
US 4545697 A	USPAT	Verdenne; Serge et al.

[12] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is currently (703) 305-0426, but will change to (571) 272-7074 in April 2005 due to a move to the Alexandria, VA campus. The examiner can normally be reached on 7:30 am - 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAS



ROBERT J. SANDY  
PRIMARY EXAMINER